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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/061,155	02/04/2002	Yoshinobu Shiraiwa	03500.016155	9159

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FITZPATRICK CELLA HARPER & SCINTO  
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NEW YORK, NY 10112

EXAMINER

HUNTSINGER, PETER K

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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07/24/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/061,155	<b>Applicant(s)</b> SHIRAIWA, YOSHINOBU	
	<b>Examiner</b> Peter K. Huntsinger	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 51-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/14/07 has been entered.

### ***Information Disclosure Statement***

2. The information disclosure statement filed 3/1/07 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 51-58 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 51, 54, 57, and 58 are rejected under 35 U.S.C. 102(e) as being anticipated by Shiohara '553.

Referring to claim 51, Shiohara '553 discloses an image pickup apparatus comprising: an image pickup unit for obtaining a digital image (col. 4, lines 4-6, CCD 2 for converting image pickup light);

an interface for connecting to a storage medium which stores the digital image obtained by said image pickup unit (col. 4, lines 6-9, signal processing section 3 outputs processed signal to frame memory 6);

a reproducing unit for reading out the digital image stored in the storage medium via said interface and causing a display apparatus to display the read-out image (col. 4, lines 35-37, frame memory 6 used as image display memory of LCD 16);

an operation unit for effecting a changeover operation of an image to be displayed on the display apparatus (Fig. 7(b));

a designating unit for designating the image displayed on the display apparatus as a print subject for a printer communicating with said image pickup apparatus (button 17 or 18 of Fig. 7(b), col. 8, lines 48-51, if user presses either button 17 or 18, the print image selection means 453 assumes the candidate image to be selected);

a display control unit for causing the display apparatus to display a print setting screen for displaying a print condition determined in advance, in accordance with a first designation provided to said designation unit when said image pickup apparatus is in a state in which an image to be displayed on the display apparatus is changeable in accordance with an operation of said operation unit (col. 8, lines 48-57, displays output method specification menu);

and a printing control unit for instructing the external printer to print the image displayed by the display apparatus, in response to a second designation provided to said designation unit successively to the first designation (col. 49, lines 46-55, if the user presses button 17 or 18, the output unit is set. The user is able to utilize button 17 for switching to the print setting screen and for printing and button 18 for setting the parameters or vice versa),

wherein while said display control unit is causing the display apparatus to display the print setting screen, the print condition can be selected by operation of an operation member different from said designating unit (col. 8-9, lines 63-67, 1-7, buttons 18 and 19 used to increment and decrement the number of print sheets).

Referring to claim 54, see the rejection of claim 51 above.

Referring to claim 57, see the rejection of claim 51 above.

Referring to claim 58, see the rejection of claim 51 above.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 52, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiohara '553 as applied to claims 51 and 54 above, and further in view of Kobayashi '717.

Referring to claim 52, Shiohara '553 discloses wherein the print setting screen is arranged so as to display a menu for instructing execution of a printing operation (Fig. 7(b), but does not disclose expressly another menu.

Kobayashi '717 teaches wherein a print setting screen is arranged so as to display a menu for instructing execution of a printing operation, and another menu, the menu for instructing execution of the printing operation being selected as a default menu in the displayed print setting screen (col. 4-5, lines 61-67, 1-7).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to include another menu on a camera. The motivation for doing so would have been to provide addition options for the user to customize. Therefore, it would have

been obvious to combine Kobayashi '717 with Shiohara '553 to obtain the invention as specified in claim 52.

Referring to claim 55, see the rejection of claim 52 above.

8. Claims 53 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiohara '553 as applied to claim 51 and 54 above, and further in view of Hatakenaka '542.

Referring to claim 53, Shiohara '553 discloses a print setting screen but does not disclose expressly a selection item of cancellation.

Hatakenaka '542 discloses a selection item of cancellation (END of Fig. 4A, col. 6, lines 38-42).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to provide a cancellation item in a menu. The motivation for doing so would have been to allow the user to stop an unwanted action. Therefore, it would have been obvious to combine Hatakenaka '542 with Shiohara '553 to obtain the invention as specified in claim 53.

Referring to claim 56, see the rejection of claim 53 above.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moe Aung can be reached on (571)272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PKH



MUNG S. MOE  
SUPERVISORY PATENT EXAMINER  
7/19/07